

Remarks

The Examiner's Answer of 06/23/2010 has been carefully reviewed and this Amendment under 37 C.F.R. § 1.111 addresses the grounds for rejection stated therein.

I. STATUS OF THE CLAIMS

Claims 1-59 and 69-80 are currently pending in the application.

Claims 60-68 were previously cancelled.

Claims 7-9, 14, 16, 19-21, 27-29, 33, and 35 have been amended to more particularly point out the subject matter of the invention. Support for these amendments can be found in Applicants' ¶¶ [0133], [0110], [0104], [0137], [0150], [0091], [0114], [0053]. No new matter has been added.

II. REJECTIONS UNDER 35 U.S.C. § 101

Beginning on page 3, the Examiner's Answer states that claims 7-16, 19-29, and 33-35 are rejected under 35 U.S.C. § 101 as not reciting patentable subject matter. More specifically, the Examiner's Answer states that, because the claims allegedly do not meet the Machine-or-Transformation (M-or-T) Test, the claims are deemed not to recite patentable subject matter and the burden is passed to Applicants to demonstrate compliance. Applicants respectfully submit that application of the M-or-T Test is insufficient to make a *prima facie* rejection under 35 U.S.C. § 101 and further, Applicants' claims are compliant with 35 U.S.C. § 101 because the claims are not directed to abstract ideas, laws of nature or natural phenomena.

Application of the M-or-T Test does not Constitute a Prima Facie Rejection under 35 U.S.C. § 101

Per *In re Oetiker*, "the [E]xaminer bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability" *In re Oe-*

tiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Applicants respectfully note that demonstrating a lack of compliance with the M-or-T Test is insufficient to make a *prima facie* rejection under 35 U.S.C. § 101. Where no *prima facie* case has been made, the burden cannot be passed to Applicants.

In its memo to Examiners regarding *Bilski*, the USPTO noted that the Supreme Court stated that the M-or-T Test is a “useful and important clue” for determining whether claims recite patentable subject matter. See *In re Bilski*, Slip Op. at 8. However, this merely means that claims meeting the M-or-T Test are likely to recite patentable subject matter. It is not dispositive that claims that allegedly fail the M-or-T Test do not recite patentable subject matter. As stated by the Supreme Court, “[a]dopting the machine-or-transformation test as the sole test for what constitutes a ‘process’ (as opposed to just an important and useful clue) violates ... statutory interpretation principles” *In re Bilski*, Slip Op. at 6-7. Rather, the only way the USPTO can currently meet its burden for rejecting claims under 35 U.S.C. § 101 is to demonstrate that the claims are directed to an abstract idea, a law of nature or natural phenomena. These are the only classes of subject matter explicitly forbidden by the Supreme Court as not being patent-eligible. Because the Supreme Court overruled the M-or-T Test as the sole test for determining patentable subject matter, the application of the M-or-T Test to pass the burden to Applicants to demonstrate patentable subject matter is improper.

The Claims Recite Patent-Eligible Subject Matter because they are not Directed to an Excluded Class

Applicants respectfully submit that the claims are patent-eligible because they are not directed to abstract ideas, laws of nature or physical phenomena. In furtherance of this, the relevant claims have been amended to more particularly point out the subject matter of the invention and to provide machine structure as supported in the specification.

Thus, the Office Action's application of the M-or-T Test does not constitute a *prima facie* rejection under 35 U.S.C. § 101 and further, the claims recite patentable subject matter that is not directed to abstract ideas, laws of nature or physical phenomena. Accordingly, it is respectfully submitted that the rejection is overcome and Applicants respectfully request that the rejection be withdrawn.

III. REJECTIONS UNDER 35 U.S.C. § 112

Beginning on page 5, the Examiner's Answer states that claims 36-47 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the Examiner's Answer states that "Applicant claims 'means for determining a target food consumption plan'...is silent as to what the corresponding structure, material or acts of this means are." (Examiner's Answer at 6.) Applicants respectfully submit that the specification does disclose adequate structure to determine a target food consumption plan. For example, in Applicants' ¶ [0133], a target food consumption plan is created based on factors which may include a user's initial weight. Specifically, "target food consumption plan may be a predetermined amount of food to consume based on food values associated with food items." (Applicants, ¶ [0133].) In this way, the system may determine a food consumption plan by calculating food value (e.g., caloric value, etc.) which will enable a user to reach his or her target weight. ¶ [0104] provides many examples on how to "value" food items, which may be based upon calories, grade, or Points, among others. As shown in Applicants' Figs. 9 and 10, the value for the food items may be tracked to insure that the user does not exceed his or her allowable limit.

The Examiner's Answer also states that Applicants' "means for automatically altering the target food consumption plan for the person at least in part on the updated weight of the person...is silent as to what the corresponding structure, material or act of

this means are.” (Examiner’s Answer at 6.) Applicants respectfully submit that the specification does disclose adequate structure. For example, Applicants ¶ [0117] states “the meal planner 306 automatically alters the dietary recommendations of the weight control program 115 (FIG. 1) based on the updated weight 322 in accordance with the general rules of the weight control program 115.”

The proper test for meeting the definiteness requirement is that the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure (or material or acts) will perform the recited function. See *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1381 (Fed. Cir. 1999). If the corresponding structure, material or acts are described in the specification in specific terms and one skilled in the art could identify the structure, material or acts from that description, then the requirements of 35 U.S.C. 112, second and sixth paragraphs are satisfied. See *Atmel Corp.*, 198 F.3d at 1382. See also *Intel Corp. v. VIA Technologies, Inc.*, 319 F.3d 1357, 1366 (Fed. Cir. 2003) (The “core logic” structure that was modified to perform a particular program was held to be adequate corresponding structure for a claimed function although the specification did not disclose internal circuitry of the core logic to show exactly how it must be modified.).

Applicants’ specification discloses “[a] weight control software system...to enhance the ability of users to follow a weight control program.” (Applicants, Abst.) Weight control programs are known in the art “[a]nd, of course, the rules of weight control programs and the food types that they prescribe are all different. The diversity of different weight control programs throughout the weight loss industry is considerable: diets range from those ordered by a physician as part of a treatment for a disease or clinical condition to calorie-counting diets, vegetarian diets, protein rich diets, sodium gram diets, fluid-restricted diets, renal diets (which utilize fluid, protein and specific electrolyte restrictions such as sodium, potassium, etc.) and cardiac diets (which utilize specific fat, salt, and cholesterol restrictions).” (Applicants, ¶ [0004].) Accordingly, it is an object of

the Applicants' system to "provide dieters with the ability to maintain food consumption within the general rules of a weight control program and to maintain motivation in following these rules." (Applicants, ¶ [0005].)

Applicants respectfully submit that one skilled in the art would appreciate the structure disclosed in the specification and request that the rejections under 35 U.S.C. § 112, second paragraph, be withdrawn in light of these remarks.

IV. REJECTIONS UNDER 35 U.S.C. § 102

On page 7, the Examiner's Answer states that claims 1-5, 7-16, 18-34, 38-42, 44-45, 48-50, 53-54, 57, 59-61, 63-64, 69-71, 74, and 76-80 are rejected under 35 U.S.C. § 102(b) as being anticipated by Mault et al. (U.S. Pat. Pub. No. 2002/0027164) ("Mault-164").

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). A missing element may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

Claim 1 recites "an input/output device operable to provide an interface for the person to operate the software and receive an updated body weight from the person" and "a . . . meal plan being automatically altered by the processor based on the updated body weight." Claims 7 and 36 recite "determining a target food consumption plan for the person based at least in part on the initial body weight" and "automatically altering the target food consumption plan for the person based at least in part on the updated weight of the person." Claim 48 recites "determine a target food consumption plan for the person based at least in part on the initial body weight . . . receive an updated weight of the person" and "automatically alter the target food consumption plan for the

person based at least in part on the updated weight of the person.” Claim 49 recites “receiving . . . a weight of the user . . . forming a dataset based on the initial profile associated with the user, the dataset including a meal plan based . . . on the weight of the user . . . receiving . . . an updated weight of the user” and “the meal plan is altered based in part on the updated weight of the user.” Claim 69 recites “a planned set of food items to be consumed based on a current weight of the person” and “software elements further operable to receive updated weight of the person to alter the planned set of food items for future food item consumption.” Claim 74 recites the “system according to claim 73, wherein the input/output device is further operable to receive an updated body weight from the person, and wherein the meal plan is automatically altered by the processor based on the updated body weight.”

Accordingly, claims 1, 7, 36, 48-49, 69 and 74 are all directed toward a system that receives an initial weight of a user, a food plan that limits the total amount of calories a user should intake on a daily basis is provided, and as the user losses weight and thereby updates their total weight in the system, the system automatically alters the food consumption allowed to the user.

In rejecting these claims, the Examiner has submitted that Mault-164 in paragraphs 57, 87 and 98 teach a shopping list is “generated automatically based on some or all of the following: usual purchase habits, dietary needs, previous purchase information, diet log information . . . [t]he PDA may suggest complete, nutritionally balanced meals to the person; message sent to client advising not to complete meal to remain on diet program; Failure to reach weight goals may be used to modify food orders placed by the PDA.” (Examiner’s Answer at 8.) Applicants respectfully disagree with the Examiner’s conclusions.

In reviewing paragraph 57, Mault-164 describes a method for “creating a shopping list” that may be “generated automatically based on . . . diet log information and purchase information (the combination of which enables an estimation of when a food

will run out).” (Mault-164 ¶ [0057]) Mault-164 further states that the “PDA may suggest complete, nutritionally balanced meals to the person, then use the chosen meals to generate a shopping list based on the meals chosen.” (*Id.*) Finally, Mault-164 states that the “diet log and previous purchase information allows the existence of currently owned items to be determined and removed from the shopping list. The PDA may question the person on whether previously purchased items (such as perishables) are still available and usable.” (*Id.*) Therefore, at most, paragraph 57 discloses that a shopping list may be generated and that a PDA may generate a shopping list that takes into consideration an individual’s preferences taking into consideration what food stuffs an individual may already have at home. Nowhere is the concept disclosed or taught that a food plan (based on a user’s weight) is altered based on an updated weight of the user.

In reviewing paragraph 87, Mault-164 describes the “advantage of having the diet business employee create the diet log” because the employee will provide “less biased estimates of portion sizes” and “the diet log can be created quickly and with little effort on the part of the person.” This portion of Mault-164 describes having a real person on the other end of a communication from the user to provide the user with advice and to keep track of what the user is actually consuming. For example, Mault-164 states that “the person enters a restaurant, chooses a food plate item from the menu” and that an “image of the delivered food is . . . captured.” (Mault-164 ¶ [0087]) The image is “transmitted via a wireless Internet connection to a remote server” and then an “employee of the diet business with access to the remote server then generates a diet log entry for the person in the restaurant.” (*Id.*) The employee may then provide advice to the user “not to complete the meal in order to remain on a diet program.” (*Id.*) While the Examiner has specifically pointed to this section of Mault-164 to teach that the system automatically adjusts a target calorie intake for the user, this is simply not true. This portion of Mault-164 teaches that an employee makes a recommendation after reviewing what the user has submitted. Also, Applicant notes that this feature of Mault-164 has nothing to do with creating the shopping list described in paragraph 57.

Finally, in reviewing paragraph 98, Mault-164 again describes using a “PDA . . . to prepare shopping lists, or to order goods and services over a communications network.” (Mault-164 ¶ [0098]) Again, Mault-164 describes there are a number of ways an individual’s shopping list may be generated, but then goes on to state that “Failure to reach weight goals may be used to modify food orders placed by the PDA, e.g. with a store, on-line business, diet plan food retailer, etc.” So, while Mault-164 discloses that a shopping list may be adjusted if an individual does not achieve a weight goal, nowhere does Mault-164 disclose that a system automatically adjusts, for example, a target calorie intake for the user based on updated weight data.

As a user of Applicants’ system loses weight, it adjusts the calorie intake for the user. Mault-164 on the other hand, suggests that a shopping list may be adjusted if a user doesn’t reach weight goals. There is no disclosure that the system performs any type of automatic adjustment based on updated weight information of the user.

Accordingly, because Mault-164 does not disclose each and every limitation of claims 1, 7, 36, 48-49 and 69, Mault-164 can not anticipate these claims. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant further respectfully submits that the Examiner’s rejection of claim 74 as anticipated by Mault-164 is inappropriate. For example, claim 74 depends from claim 73 and necessarily includes all the limitations of claim 73. However, as claim 73 was not subject to a rejection under 35 U.S.C. § 102(b), a rejection of claim 74 is inappropriate. Accordingly, as claim 74 includes all the limitations of claim 73, claim 74 cannot be anticipated by Mault-164.

The Examiner has submitted that “Mault-164 teaches, ‘Failure to reach weight goals may be used to modify food orders placed by the PDA’ (paragraph 98).” (Examiner’s Answer at 28.) The Examiner then goes on to state that it “is inherent within

this reference that the only way to know that weight goals have not been met is to have updated weight information” and that the “introduction of new weight information will inform the system that the food order has to be changed to reflect the change in the user’s weight.” (*Id.*)

The Examiner appears to tacitly admit that Mault-164 does not explicitly disclose a “meal plan being automatically altered by the processor based on the updated body weight”, but that somehow, the disclosure must be there. In support of the inherency argument, the Examiner concludes that the user must provide updated weight information to the system so that the system adjusts a shopping list. This is not true. For example, the system could prompt the user to indicate whether or not a weight goal had been achieved and the user could indicate either that they did or they did not. While the Examiner seeks to alter the claim language to broadly read receiving weight information, claim 1, for example, recites “receive an updated weight of the person.” The system in Mault-164 does not have to “receive an updated weight of the person” to adjust a shopping list. The entire premise of an inherency argument is that the limitation is “necessarily present” as there is no other way the system could function. *Cont’l Can Co. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). However, the system in Mault-164 does not necessarily have to “receive an updated weight of the person” to adjust a shopping list as stated above and, as a result, the inherency argument fails.

Another issue is the fact that Applicants’ claims recite “a meal plan” or “target food consumption plan” and adjustment of the plan based on receiving an updated weight of the individual. On the other hand, the section of Mault-164 that the Examiner points to as modifying food orders based on failure to reach weight goals is limited to the generation of “shopping lists,” and not to a particular “meal plan.” In other words, the system in Mault-164 takes many things into consideration in the generation of the list of food a user should purchase at the supermarket, one of those things being whether a user has reached a weight goal, and based on that information, the system in Mault-164 may adjust a weekly shopping list. However, claim 1, for example, is directed

toward a system that will adjust individual meals providing precise controls to the individual based on an updated weight of the individual. Direction relating to individual meals addressed in Mault-164 is only by means of live personnel providing feedback to a user relating to a particular meal. (Mault-164 ¶ [0074]) Accordingly, Applicant respectfully submits that modifying a weekly shopping list is not the same as modifying a particular meal plan. In fact, Mault-164 differentiates between the shopping list and a particular meal, but never states that a meal is adjusted based on an updated weight of a user. (Mault-164 ¶¶ [0057], [0098]).

The Examiner has further submitted that claims 10-13, 22 and 74 are written with language that can be considered non-functional descriptive data. (Examiner's Answer at 29-30.) The Examiner also states that "this data adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims."

Claims 10-13 recite pre-established or pre-determined "set[s] of foods." Claims 22 recites "wherein the demographical information includes at least one of the following: gender, race, and ethnicity." Claim 74 recites "wherein the input/output device is further operable to receive an updated body weight from the person, and wherein the meal plan is automatically altered by the processor based on the updated body weight."

Claims 10-13 ultimately depend from claim 9. Claim 9 is a method claim that includes the step of "selecting, on a computer, a meal plan from a predetermined set of foods." Claims 10-13 add the limitation relating to the set of foods. Claim 22 ultimately depends from claim 7. Claim 7 is a method claim that includes the steps of "receiving an updated weight of the person" while claim 22 recites various demographical information that is also received by the system. Claim 22 is a method claim that adds the step of receiving particular information that can be used by the system. For example, a person's gender, race and ethnicity may have a bearing on how fast a person burns calories and therefore can be taken into consideration when suggesting a particular meal. This information allows the system to be further customized to the user. Claim 74 de-

pendes from claim 73 and provides for specific functionality of the input/output device, namely that it is “operable to receive an updated body weight” and provides the additional functionality that “the meal plan is automatically altered . . . based on the updated body weight.”

Applicant does not see how the specifically recited functionality can be characterized as “non-functional descriptive data.” The functionality is specifically claimed. If the Examiner is to maintain this rejection, Applicants respectfully request that the Examiner point out how the recited claim language fails to be limiting.

Applicant submits that Mault-164 at least does not disclose Applicants’ system that receives an initial weight of a user, a food plan that limits the total amount of calories a user should intake on a daily basis is provided, and as the user losses weight and thereby updates their total weight in the system, the system automatically alter the food consumption allowed to the user. For the reasons stated above, Mault-164 fails to teach, disclose or even suggest all of the claim limitations of independent claims 1, 7, 36, 48-49, and 69 and dependent claim 74. Dependent claims 2-5, 8-16, 18-34, 38-42, 44-45, 50, 53-54, 57, 59-61, 63-64, 70-71, and 76-80 are not anticipated by Mault-164 at least by virtue of their dependence on the independent claims, which are believed to be in condition for allowance.

V. REJECTIONS UNDER 35 U.S.C. § 103

Beginning on page 20, the Examiner’s Answer states that claims 6, 35, 37, 43, 46-47, 52, 55-56, 58, 72, 73, and 75 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mault-164 in view of Mault et al. (U.S. Pat. Pub. No. 200/0062069) (“Mault-069”).

In addition to the above remarks, Applicants further respectfully submit that independent claims 1, 7, 36, 48-49, 69 and 73 are not obvious. For a claim to be rejected

as obvious, the Office is required to determine the scope and content of the prior art, ascertain the differences between the claimed invention and the prior art, and resolve the level of ordinary skill in the art. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007); MPEP § 2141, citing *Graham v. John Deere Co.*, 383 U.S. 1 (1966). This analysis must be set forth explicitly. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). When considering the prior art, the office is required to consider the prior art as a whole, and may not disregard portions of the art which show that an invention is not obvious. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976).

The Examiner's Answer rejects a number of Applicants' dependent claims as obvious over the cited references. In addition, the Examiner's Answer rejects independent claim 73. Claim 73 recites "a display operable to present the meal plan to the person, the meal plan being displayed in a multi-day format and including a user selectable indicium operable to be utilized by the person in order to display the meal plan for a particular one of the days displayed in the multi-day format."

The Examiner's Answer notes the deficiencies of Mault-164 in relation to the rejected claims. For example, the Examiner's Answer submits that while Mault-164 does not teach the limitations of claim 73, it argues that Mault-069 does teach the limitation at "Figs. 11A, 11B and Fig. 20 – diet information can be displayed for the day or the week." (Examiner's Answer at 25.) The Examiner further states that one "of ordinary skill in the art would understand that Mault-164 relates to a weight management system" that "provides monitoring of consumption allowing a client to enter information into a diet log and personal information into the system regarding their weight, age, gender and other fac-

tors.” (*Id.*) The Examiner further submits that “[c]lients are provided a shopping list which is ‘generated automatically based on some or all of the following: usual purchase habits, dietary needs, previous purchase information, diet log information . . . [t]he PDA may suggest complete, nutritionally balanced meals to the person.’ (paragraph 57). Mault-069 provides diet information in the form of caloric intake and meal information. This information can be displayed on the basis of a day or a week.” (*Id.*)

Applicants note that it appears the first basis the Examiner relies on to support the combination of the two cited references is that they are analogous art. The second basis provided by the Examiner for combination and modification is that the system of Mault-164 “provides monitoring of consumption allowing a client to enter information into a diet log and personal information into the system regarding their weight.” (*Id.*) Even if this were so, which Applicants dispute, there is no articulated reason given by the Examiner as to why one would modify Mault-164 according to the presently pending claims.

Obviousness requires “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385 (2007). The Examiner bears the burden of establishing a factual basis to support a legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. (*Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

The Examiner then states that “[i]f Applicant claims a journal system it would be obvious that this system is portable” and that “Mault-164 provides a portable weight

management system that enable a client to manage their weight throughout the day.” (Examiner’s Answer at 31.) These statements are confusing and don’t appear to provide any motivation for combination of Mault-164 with Mault-069. The statement relating to “[i]f Applicant claims a journal system” has no relation on claim 73. It’s clear what claim 73 claims, which is a “system for facilitating the control of body weight of a person.” The issue of portability is never mentioned in claim 73.

Here, we find that the Examiner has not provided a reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention, but instead simply stated that they could have been combined. It is incumbent upon the Examiner to establish the factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). It does not matter how strong the Examiner’s convictions are that the claimed invention would have been obvious, or whether we might have an intuitive belief that the claimed invention would have been obvious within the meaning of 35 U.S.C. § 103 as neither circumstance is a substitute for evidence lacking on the record.

It is the Examiner’s burden to establish prima facie obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). As stated above, obviousness requires “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007). Without an articulated reason to combine the element in the way the claimed new invention does, there can be no prima facie obviousness. The Examiner has failed to provide this reason to combine and there the Examiner’s rejection under 103 is improper.

Further, it is important to guard against the use of hindsight when evaluating whether a claim is obvious. *E.g.*, *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (“A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.”). As a guard

against hindsight, courts have identified certain scenarios in which it is improper to reject a claim as obvious. For example, a claim cannot properly be rejected as obvious when the principle of operation of the prior art would need to be modified to obtain the claimed invention. *In re Ratti*, 270 F.2d 810 (CCPA 1959) (cited in MPEP 2143.01 for the proposition that "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."). Similarly, if a prior art reference teaches away from a claimed invention, then the claimed invention is not obvious over that prior art. See MPEP § 2145 citing *In re Grasse*, 713 F.2d 731 (Fed. Cir. 1983).

Independent claims 1, 7, 36, 48-49, 69 and 73 all recite a food plan being automatically altered by the processor based on an updated body weight. Mault-164 specifically teaches that the "authorized people . . . may access the data" to provide feedback. (Mault-164 ¶ [0074].) Accordingly, while customized feedback may be provided to a user, the feedback is based on review by live personnel of the data provided by the user. Nowhere does Mault-164 disclose or teach automatic alteration of a food plan based on inputted data. Accordingly, Applicant respectfully submits that not only does Mault-164 fail to teach a meal plan being automatically altered by the system, but actually teaches away from this limitation.

Accordingly, Applicant respectfully submits that independent claims 1, 7, 36, 48-49, 69 and 73 cannot be obvious in view of the references cited by the Examiner. Dependent claims 6, 35, 37, 43, 46-47, 52, 55-56, 58, 72, 74, and 75 are not rendered obvious at least because of their dependence on the independent claims, which are believed to be in condition for allowance.

On page 26 of the Examiner's Answer, claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Mault-164 in view of Jill Barker. Claim 17 depends from claim 16, which further depends from claim 7. Accordingly, claim 17 includes all of

the limitations of claims 7 and 16 and therefore is allowable for the same reasons stated in connection with claim 7 listed above.

On page 27 of the Examiner's Answer, claim 51 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Mault-164 in view of Admitted Prior Art. Claim 51 depends from claim 49. Accordingly, claim 51 includes all of the limitations of claim 49 and therefore is allowable for the same reasons stated in connection with claim 49 listed above.

VI. PROVISIONAL REQUEST FOR INTERVIEW

Should the amendments and remarks submitted herewith fail to persuade the Examiner, Applicants respectfully request an interview to discuss putting the application in condition for allowance. The Examiner is also invited to contact the Applicants through their designated representatives indicated below.

VII. CONCLUSION

The Examiner's Answer dated 06/23/2010 contained new grounds of rejection. Accordingly, Applicants request that prosecution be reopened with the filing of this response. This response addresses the grounds for rejection and it is respectfully submitted that claims 1-59 and 69-80 are believed to be in condition for allowance. This response is timely filed on or before 08/23/2010, or within two months of the Examiner's Answer dated 06/23/2010. Applicants believe that no fee is due in connection with the filing of this Amendment. However, The Commissioner for Patents is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 19-4516.

Respectfully submitted,

August 23, 2010

/ Wesley W. Whitmyer, Jr./

Wesley W. Whitmyer, Jr., Registration No. 33,558
Todd M. Oberdick, Registration No. 44,268
Stephen Ball, Registration No. 59,169
Attorneys for Applicants
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
Tel. 203 324-6155